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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

Applicant(s) : Alain Zanco
Serial No. : 09/172,830
For : **BOOT FOR SKI OR IN-LINE ROLLER SKATE**
Filed : October 15, 1998
Examiner : J. Kavanaugh
Art Unit : 3728

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ORIGINALLY FILED**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on August 15, 2002.

Ronald R. Santucci, Reg. No. 28,988

Name of Applicant, Assignee or Registered Representative

Ronald R. Santucci
Signature

August 15, 2002

Date of Signature

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TRANSMITTAL OF REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Assistant Commissioner of Patents
Washington, D.C. 20231

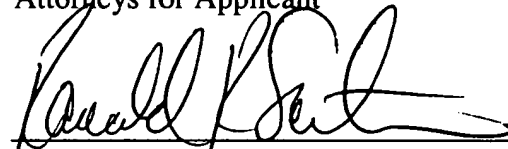
Sir:

Applicants enclose herewith in triplicate their Reply Brief Under 37 C.F.R. 1.193(b)(1) which is being filed in response to the Examiner's Answer dated June 27, 2002. In addition, Applicants enclose in triplicate their Request for an Oral Hearing. Enclosed is a check for \$280 which includes the requisite fee for the request for an oral hearing (for a large entity). The Commissioner is authorized to charge any fees that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicant

By:

A handwritten signature in black ink, appearing to read "Ronald R. Santucci", written over a horizontal line.

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REPLY BRIEF UNDER 37 C.F.R. 1.193(b)(1)

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

This Reply Brief is being filed in response to the Examiner's Answer dated June 27, 2002. This Reply Brief is filed in triplicate.

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ARGUMENT

This Reply Brief is being filed in response to several points of argument raised by the Examiner in the Examiner's Answer. It is believed that no fee is required for the consideration of the Reply Brief. If, however, a fee is due, the Assistant Commissioner is authorized to charge such fee, or credit any over payment to Deposit Account No. 50-0320. Filed currently herewith is a Request for Oral Hearing, also in triplicate.

Claims 1-3, 5, 8 and 9 stand rejected under 35 U.S.C. §112, second paragraph. In Paper No. 29, the Office Action of November 29, 2001 (paper # 29) alleges that the phrase "interlocking surface means" is unsupported in the specification and is indefinite. In the Examiner's Answer, the rejection is maintained and additionally, the Examiner states on page 7 of the Answer that because the phrase "interlocking surface means" cannot be found in the specification, its meaning is imprecise. Further, in response to Appellant's citation to portions of the specification supporting the term "interlocking surface means," the Examiner alleges nevertheless that the term is still unclear.

For the reasons provided below, Appellant respectfully disagrees with the position of the Examiner. Appellant submits that the claims meet the requirement of 35 U.S.C. 112, second paragraph, as the specification provides support for the term "interlocking surface means". See Figures 7 and 8 and page 7, lines 14-20:

The rigid part 1 of the sole may have **other ski binding means** intended to engage with a ski or skate binding. In the embodiment which is represented in Figures 7 and 8, these binding means consist of two pairs of lateral pins 9 and 10 which are intended to engage in the notches of the binding and are capable of being **locked** in these notches.

Contrary to the assertion of the Examiner, the term "interlocking surface means" has clear and definite meaning when read in light of the specification and the rest of the claim language. Further, the term is definite and encompasses subject matter which is adequately described in the specification including the drawings and claims as originally filed.

A claim is definite if the scope of the subject matter embraced by a claim is clear and if the applicant has not otherwise indicated that he intends the claims to be of a different scope. In re Borkowski, 164 USPQ 642 (CCPA 1970). The "distinctly claim" requirement of 35 USC § 112, second paragraph, means that the claims must have a clear and definite meaning when construed in light of the complete patent document. Standard Oil Co. v. American

Cyanamid Co., 227 USPQ 293 (Fed. Cir. 1985). The test of definiteness is whether one skilled in the art would understand the scope of the claim when read in light of the specification.

Morton Int. Inc. v. Cardinal Chem. Co., 28 USPQ2d 1190 (Fed. Cir. 1993). The degree of precision necessary is a function of the subject matter claimed. Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 94-95 (Fed. Cir. 1986). Indeed, the Federal Circuit noted in Hybritech that:

‘[I]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more’ [and] the claims are clearly definite.

Id at 94 (citing to Shatterproof Glass Corp. v. Libbey Owens Ford Co., 225 USPQ 634,641 (Fed. Cir. 1985)) (emphasis added).

Applying the law to the instant facts, as the instant claims, read in light of the specification, apprise a skilled artisan of both the utilization and scope of the invention, and as the language is as precise as the subject matter permits, the instant claims are definite. A contrary conclusion, as posited by the Examiner’s Answer, would not only be against public policy, but also impermissible as a matter of law. Hybritech, 231 USPQ at 95 (“As a matter of law, no court can demand more.”).

Specifically, and for the reasons that follow, Applicants respectfully urge that the term “interlocking surface means” conveys a clear meaning to a practitioner in this art when the term is read in the context of the rest of the claim and in light of the specification. Moreover, Applicants urge that this language is precise in view of the nature of the claimed subject matter.

The term “interlocking surface means” is used in claim 1 to refer to the embodiment which is represented in Figures 7 and 8 as reiterated above. Specifically, the claim 1 states:

...wherein the sole has a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and
wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

(Emphasis added).

In response to the Examiner’s assertions at page 7 of the Examiner’s Answer that claim 1 is indefinite, Appellant emphasizes that from the context of the above-quoted limitation,

it is clear that the term "an interlocking surface means" refers to other ski binding means which is capable of being locked into the notches of the binding of the boot to a ski or skate.

In view of the foregoing, Applicants urge that the specification and claims clearly define, and that, accordingly, the 112, second paragraph rejection should not be sustained.

Claims 1, 2 and 8 stand rejected under 35 U.S.C. §102(e) as allegedly anticipated by Bourque (U.S. Patent No. 4,674,202); claims 1-3 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Gladek (U.S. patent No. 4,246,708); and claims 1, 3 and 9 as allegedly anticipated by Donnadieu (U.S. Patent Nos. 5,884,420 and 5,899,006).

On page 9 of the Examiner's Answer, the Examiner concedes that "none of the [reference] patents show the binding means as shown by figures 7 and 8 [of Appellant's specification]." The Examiner nevertheless concludes that the references show structure inherently capable as serving as the interlocking surface means. For the reasons provided below, Appellant respectfully disagrees with the position of the Examiner.

It is not enough for one to contend that the structural elements in the relied-upon references "inherently" speak to the instantly claimed invention. The references must disclose or suggest the properties for inherency to attach. According to *In re Rijckaert*, 9 F.3d 1531, 1957 (Fed. Cir. 1993), "such a retrospective view of inherency is not a substitute for some teaching or suggestion[.]" The Federal Circuit is clear that "'inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient [to establish inherency].'" *Continental Can Company v. Monsanto Company*, 948 F.2d 1264, 1269 (Fed. Cir. 1991), citing to *In re Oelrich*, 666 F.2d 578, 581-582 (C.C.P.A. 1981). Indeed, "before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference." *SGS-Thomson Microelectronics, Inc. v. International Rectifier Corporation*, 31 F.3d 1177 (Fed. Cir. 1994) (emphasis in original). Applying the law to the instant facts, none of the documents cited in the Office Action inherently teach, disclose or suggest the Applicants' invention.

That is, none of the documents inherently teach, disclose or disclose, *inter alia*, a boot for a ski or in-line roller skate, the boot having a sole with a heel portion and a front portion, the sole being connected to a flexible upper, wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole, wherein the sole has

a flexible portion which extends from the front portion rearward to the first rigid part so as to allow the foot to flex during walking, and wherein the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion.

Thus, inherency cannot attach.

With respect to the Examiner's statements on page 9 that "Bourque has a cutout in the rear part of the sole much like applicant's cut-out (7) shown in figures 3 and 4," Appellant respectfully disagrees, and asserts that Bourque fails to teaches Appellant's invention. In fact, the Examiner concedes this point and states on page 10 that "neither patent [Bourque and Salzman] teaches what this cut out is for." Consequently, reversal of the Section 102 rejections are believed to be in order and such action is respectfully requested.

Claims 5 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over either Donnadiou (U.S. Patent Nos. 5,899,006 and 5,884,420) or Gladek in view of Bourque (U.S. Patent No. 4,674,202) and Salzman (U.S. Patent No. 4,186,500), and claims 3 and 5 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over either Bourque in view of Donnadiou or Gladek.

On page 10 of the Examiner's Answer, the Examiner alleges because Salzman and Bourque both show a cut-out in the rear section of the sole, the references therefore teach Appellant's invention. Appellant respectfully disagrees, and asserts that such disclosure fails to even suggest the instant invention claimed in claim 1. As noted previously, the Examiner in fact concedes that "[n]either patent teaches what this cut-out is for."

Further contrary to the Examiner's conclusion, neither of Donnadiou or Gladek or Bourque or Salzman, either alone or in combination teach or suggest the instant invention according to claim 1, i.e., a boot for a ski or in-line roller skate, the boot wherein the sole has a first rigid part which extends forward from said heel portion over about one half of the length of the sole and the first rigid part includes an interlocking surface means which interlocks with a binding of an alpine ski or in-line roller skate thus firmly fixing the first rigid part against flexing with respect to the flexible portion. Therefore, none of the cited references either alone or in combination teach or suggest the instant invention according to claim 1 let alone claims 3, 5 or 8.

It is well established that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the teachings of Donnadiou,

Gladek, Bourque and Salzman. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Indeed, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." For a Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

In the present situation, Donnadieu, Gladek, Bourque and Salzman fail to provide the necessary incentive or motivation that would lead a skilled artisan to practice the present invention. That is, Donnadieu, Gladek, Bourque and Salzman do not disclose or suggest the boot for a ski or in-line roller skate with a interlocking surface means at the rear of the boot which interlocks with a binding of an alpine ski or in-line roller skate as instantly claimed.

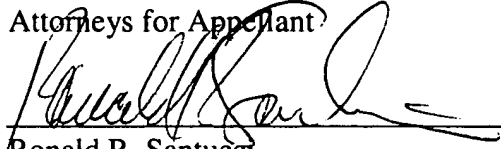
Consequently, a reversal of the Section 103(a) rejection is believed to be in order and such action is respectfully requested.

CONCLUSION

Thus, in view of the foregoing, it is respectfully submitted that the rejections under 35 U.S.C. §§ 112, second paragraph, 102(e) and 103(a) should be reversed.

Respectfully submitted,
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